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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,686	02/06/2004	Eric Vandewater	SUNX-0022US	7811

7590 06/16/2005  
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EXAMINER

AUGUSTIN, EVENS J

ART UNIT PAPER NUMBER

3621

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/773,686	Applicant(s) VANDEWATER ET AL.	
	Examiner Evans Augustin	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07/08/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

***Status of Claims***

1. Claims 1-29 have been examined.

***Claim Rejections - 35 USC § 112***

2. The term "selectively" in claim 1, 3-4, 9, 11, 17-18, 20, 22 is a relative term which renders the claim indefinite. The term "selectively" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.
3. Claims 2, 5-8 and 10 are also rejected as they depend on claim 1. Claims 12-14 are also rejected as they depend on claim 11.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-29 are rejected under 35 U.S.C. 102(e) as being anticipated by Risan et al. (U.S. 6,804,779).

As per claims 1-29, Risan et al. discloses a computer system that relates to preventing unauthorized recording of electronic media. The computer system comprises of the following:

- Determining whether digital content is protected (page 12, paragraph (¶) 105), and limiting which software programs are permitted to access digital content (page 7, ¶ 69)-  
*Claims 1, 15*
- Including one or more computer usable data storage device coupled to bus for storing instructions and information, in one embodiment of the present invention. In one embodiment, data storage device can be an optical storage device, e.g., a CD (compact disc) (page 3, ¶ 35) – *Claim 11*
- Risan's invention describes a copyright compliance mechanism (CCM), which detects and control the rights involved in digital content. The CCM can include many media drivers and therefore supports many different types of audio media files (page 7, ¶ 68). Therefore, DRM protocols would still be followed while converting from one audio format to the next – *Claims 5, 20, 21, 25*
- Extracting rights from content (page 5, ¶ 52) - *Claim 20*
- Including ripper applications that capture the media file and change the format of the media file (page 7, ¶ 68). Also includes burner applications (page 7, ¶ 68), and the ability to burn songs on CD (page 4, ¶44) – *Claim 8, 25*
- Monitor data stream between hardware and program (page 10, ¶ 86) – *Claims 2, 16*
- Control access to data from hardware device (page 8, ¶73) – *Claims 1, 3, 15, 17*
- Accessing digital content with a program and using program to convert content into a second format (page 7, ¶ 68) – *Claim 4*
- The source of the content can from a CD, DVD or MP3 player (page 10, ¶ 89). The copyright restrictions and licensing agreements are still applicable (page 10, ¶ 88).

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Risan's system has means to detect when an audio file is inserted for playback and recording (page 11, ¶ 91) – *Claims 5-8, 12, 14*

- Copyright compliance mechanism (CCM) further includes one or more coder/decoders (codec) that, in one embodiment, is/are adapted to perform, but is/are not limited to, encoding/decoding of media files, compressing/decompressing of media files, detecting that delivered media files are encrypted as prescribed by CCM (page 5, ¶ 52).

Coder/decoders can be utilized in conjunction with various types of copyrighted media content (page 5, ¶ 53) – *Claims 18, 26*

- Denying unauthorized access to user that don't adhere to copyright policies (page 8, ¶ 76) – *Claim 19*
- Selectively control unauthorized access of content (lock/unlock) (page 18, ¶ 161, page 1, ¶ 11-12) – *Claims 9-10, 22*
- Digital content is recordable and readable by user PC – (page 6, ¶ 60) – *Claim 23*
- Red Book is the 1980 document that provides the specifications for the standard compact disc (CD) developed by Sony and Philips and is well known – *Claim 13*
- Providing DRM licensing to user computer, and extracting licensing conditions from content (page 4, ¶ 43-44) - *Claim 24*
- Client system contains media player applications such as RealPlayer, Itunes and Windows Media player capable of playing audio content from a CD (page 8, ¶ 75) – *Claims 28-29*
- Content providers or copyright holders grant permission to contents (page 4, ¶ 44) - *Claim 28*

- Allowing to save music to MP3 player (page 4, ¶ 44) – *Claim 27*

### ***Conclusion***

6. Ripping songs from CDs and compressing them are well known (See Cookson - US: 6591365 – column 1, lines 1-22).
7. Burning data on CDs is also well know (See Ihde et al. – US: 20030101315, page 1, ¶ 4)
8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
  - **Isaacson et al. (US 20020196941)** - Invention relates generally to a method, device and system for providing secure digital sound recording
  - **Hurtado et al. (US 6611812)** - System and related tools for the secure delivery and rights management of digital assets, such as print media, films, games, and music over computer readable medium such as CDS and DVDs
  - **Risan et al. (US 20050060542)** - Method for providing media content while preventing its unauthorized distribution
  - **Heller (US 20050102191)** - Method of retailing electronic media, wherein the content of the media is maintained in digitized format

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin  
June 13, 2005  
Art Unit 3621

  
SALVATORE CANGIALOSI  
PRIMARY EXAMINER  
ART UNIT 222